

## REMARKS

The present application includes pending claims 16, 17, and 20-31, all of which have been rejected. The Applicants respectfully submit that the claims define patentable subject matter.

### **I. Priority Of The Present Application**

The specification was objected to because “it does not contain the priority of application 07/864,7077 [sic] as a CIP of application 07/538,981, in it’s [sic] first sentence.” *See* March 19, 2007 Office Action at page 2. The Applicants have amended the specification to recite that U.S. Patent No. 5,355,302 is a continuation-in-part of serial No. 07/538,981, filed June 15, 1990, which is now abandoned.

The present application claims priority to United States Patent No. 5,355,302, which **was filed March 6, 1992** (the “’302 patent”), which is a continuation-in-part of serial no. 07/538,981, filed June 15, 1990. The Applicants note that the priority date for the ‘302 patent is **March 6, 1992**, not March 6, 1998, as indicated in the Office Action. *See* March 19, 2007 Office Action at page 2.

### **II. The ‘302 Patent Provides Support For The Claims**

Next, the Office Action asserts that “the disclosure of the prior-filed CIP application, Application No. 07/5338,981, [sic] filed 6/15/1990, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112, for the attract mode in one or more claims of this application.” *See* March 19, 2007 Office Action at page 2.

As discussed above, the present application claims priority to the '302 patent. Both the present application and the '302 patent provide support for, and enable, the claims. As but one example of this enabling support, both the present application and the '302 patent state the following:

FIG. 5 is a flow-chart illustrating the specific operation of the processing circuit 121 of the jukebox 13 in interfacing with the user. At a block 161, if no song selection is playing, the processing circuit 121 operates in a user attract mode, displaying a random sequence of available graphic images on the visual display 125. More particularly, the processing circuit 121 randomly selects a starting address of the compressed graphics data from the available song records 29 in the catalog 95. From that starting address, the circuit 121 retrieves the data from the song library 91 via the bus 124. The circuit 121 decompresses and transfers the data along the bus 124 to the visual display 125 for display. Thereafter, the circuit 121 again randomly selects a starting address of available graphics data and this cycle repeats. If, however, a song selection is being played when the block 161 is encountered, the attract mode sequencing does not occur. Instead, the circuit 121 displays the associated graphics image of the song being played on the display 125. During the attract mode the processing circuit 121 may also control the display 125 to present a prompt requesting customers to enter new song requests. The new song request data entered by a customer using the keyboard is stored and uploaded to the management system 11 to aid the system 11 in determining whether new song data should be downloaded to the jukebox.

*See* present application at page 12, lines 8-37, and the '302 patent at column 6, line 59 to column 7, line 17. This example from the present application and the '302 patent teaches those in the art enough that they can make and use the claimed inventions without “undue experimentation.” *See* MPEP § 2164.01 and *Amgen, Inc. v. Hoechst Mariou Roussel, Inc.*, 314 F.3d 1313, 1334, 65 USPQ2d 1385, 1400 (Fed. Cir. 2003). Further, “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the

entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” *See* MPEP § 2164.01(b), *citing In re Fischer*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

For at least the reasons discussed above, the Applicants respectfully submit that the present application and the ‘302 patent both contain support for the claims of the present application, and satisfy the enablement requirement. Thus, the Applicants respectfully request reconsideration of this rejection.

### **III. The Office Action Has Not Established A Prima Facie Case Of Obviousness With Respect To Claims 16-17, 20, 22-23, And 25-26**

Claims 16-17, 20, 22-23, and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,497,502 (“Castille”) in view of United States Patent No. 4,949,187 (“Cohen”) and United States Patent No. 6,601,150 (the “Smith patent”). Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of Cohen, the Smith patent, and United States Patent No. 4,667,802 (“Verduin”). Claims 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of the Smith patent. The Applicants respectfully traverse these rejections for at least the following reasons:

Initially, the Applicants note that the Smith patent forms the basis for rejecting all of the pending claims of the present application with respect to 35 U.S.C. § 103. As discussed below, however, the Office Action has not shown that the Smith patent qualifies as prior art with respect to the compression/decompression and user attract limitations recited in the claims of the present application. Thus, the Office Action has not established a prima facie case of obviousness with respect to the pending claims.

The Smith patent is a continuation of United States Application No. 08,435,125, filed May 5, 1995 (the “Smith ‘125 CIP”), which is a continuation-in-part of United States Application No. 07/815,217, filed December 31, 1991 (the “Smith ‘217 application”). *See* Smith at column 1, lines 5-8. As discussed above, the ‘302 patent, from which the present application claims priority, was filed March 6, 1992. The filing date of the ‘302 patent antedates the Smith ‘125 CIP, but is after the Smith ‘217 application. Thus, in order to establish a *prima facie* case of obviousness, the Office Action needs to show that the Smith ‘217 application discloses the relevant limitations.

The Office Action cites the Smith patent at column 7, lines 63-66 as disclosing “compressing and decompressing video and audio data” and an “attract mode.” *See* March 19, 2007 Office Action at pages 4, 5, 7, and 8. (“Smith et al (‘159) teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66 to increase machine usage.”). The portion of the Smith patent relied on by the Office Action states the following:

Among the types of information which may be provided to a system user spontaneously by the integrated information support system are “special frames,” such as graphics displayed during idle time, run time and warmup.

*See* the Smith patent at column 7, lines 63-66. Initially, the Applicants do not necessarily agree or disagree that the portion of the Smith patent relied on by the Office Action (by itself or in conjunction with other cited references) discloses “a user attract-mode in which the digitally-stored song associated graphics are decompressed and shown on said display when no selected

song is playing on the computer jukebox,” as recited, for example, in claim 29 of the present application.

The Applicants acknowledge that the portion of the Smith patent relied on by the Office Action is recited in the Smith ‘125 CIP. *See* the Smith ‘125 CIP at page 12, lines 11-16. Thus, the Smith patent provides support for this cited portion as of May 5, 1995, which is over three years after the filing date of the ‘302 patent.

The Smith ‘217 application does not, however, recite this passage from the Smith patent that is relied on by the Office Action. Further, the Smith ‘217 application is the only application within the Smith chain of priority that antedates the filing date of the ‘302 patent, which is in the priority chain of the present application. Thus, the Office Action has not established that the Smith patent qualifies as prior art with respect to the “compression and decompression” and “user attract” limitations of the present application. For at least these reasons, the Applicants respectfully request reconsideration of the 35 U.S.C. § 103 rejections.

#### **IV. Conclusion**

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness with respect to any of the pending claims for at least the reasons

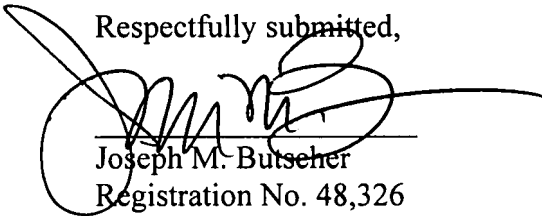
discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants.

The Commissioner is authorized to charge any necessary fees, including the fee for the extension of time in which to respond, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

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Respectfully submitted,



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